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Paper No. 24
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re CompUSA Management Co.

Serial No. 75/110,434

Herbert J. Hammond of Thompson & Knight for CompUSA Management Co.

Dominic J. Ferraiuolo, Trademark Examining Attorney, Law Office 102 (Thomas V. Shaw, Managing Attorney).

Before Cissel, Wendel and Bucher, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

Applicant has appealed from the final refusal to register the mark "THE COMPUTER SUPERSTORE" on the Principal Register for "retail store services in the field of computers, computer products and computer accessories," in Class 42. The application was filed on May 28, 1996, based on a claim of use of the mark in commerce since September of 1989. The Examining Attorney refused registration under Section 2(e)(1) of the Lanham Act, 15

U.S.C. Section 1052(e)(1), on the ground that the mark is merely descriptive of the services recited in the application. Applicant's claim of distinctiveness under Section 2(f) of the Act was rejected by the Examining Attorney, who at this point held that the words sought to be registered are generic in connection with these services, and that as such, they are not capable of identifying applicant's services and distinguishing them from similar services provided by others.

Applicant disputes that the words sought to be registered are merely descriptive in connection with its services, much less that they are generic, but applicant has nonetheless submitted substantial evidence in support of its claim that as a result of applicant's extensive use and promotion of "THE COMPUTER SUPERSTORE" as applicant's mark, it has become distinctive of applicant's services.

The appeal was fully briefed, including supplemental briefs and a reply brief, and both counsel for applicant and the Examining Attorney presented arguments at the oral hearing before the Board on the date indicated above.

The test for mere descriptiveness is not in dispute in this appeal, nor is the test for genericness. A mark is merely descriptive of services, and hence unregistrable on the Principal Register without evidence of secondary

meaning, if it forthwith conveys information concerning a significant feature, function, purpose or use of the services. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). A term is generic, i.e., so descriptive that no amount of de facto significance as a source indicator can justify its registration on the Principal Register, if the relevant public understands the term primarily to refer to the class of goods or services with which it is used. In re The American Fertility Society, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc., 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986).

Responsive to the original refusal to register on the ground of descriptiveness, applicant cited several third-party registrations for marks which combine what appear to be generic terms with the word “SUPERSTORE” for services involving the sale of products encompassed within the generic terms. Examples included “SECURITY SUPERSTORE” for mail order catalog services featuring security systems and equipment, and “BABY SUPERSTORE” for retail store services in the field of baby products. Applicant argued that the generic term to describe its services is “a computer store,” but that “the computer superstore” is not a term

used by the relevant public to name the class or category of services which applicant renders.

In support of his conclusion that the term applicant seeks to register is the name of the class of services at issue and that the relevant public understands this designation primarily to refer to this class of services, the Examining Attorney has made of record a substantial amount of evidence. Attached to the second Office Action were copies of a number of third-party registrations for marks used in connection with retail store services in various fields. In each instance, the word “SUPERSTORE” is disclaimed, along with the generic term for the goods or services in connection with which the mark is registered. For example, in Reg. No. 2,172,306, wherein the services are identified as retail store services in the field of medical and health care products, the words “THE HEALTHCARE SUPERSTORE” are disclaimed; and in Reg. No. 2,083,786, wherein the services are identified as retail store services in the field of office supplies and equipment, the words “OFFICE” and “SUPERSTORE” are both disclaimed.

Also included were copies of a number of Patent and Trademark Office records regarding applications wherein generic terms for the goods or services specified in such

applications and the word “SUPERSTORE” have both been disclaimed.

In addition, the Examining Attorney included many excerpts retrieved from the Nexis automated database of published articles. These articles show the word “superstore” used generically in connection with large-scale retail sales services in a variety of fields, including, inter alia, shoes, automobiles, banking, books, and, significantly, computers. Typical examples of the later include the following: “Computer superstores, office supply outlets and mass merchandisers attract armies of customers--from small-business people to refugees from large corporations looking for the latest in technology. Time spent at the computer superstore can be informational and recreational.” (The Houston Chronicle, July 6, 1997); “CompUSA [applicant in the instant appeal] is doing very well--they’re well ahead in store count and volumes--but I don’t think there will be just one national computer superstore player.” (Computer Retail Week, July 21, 1997); “But before you run out to a computer superstore, check the Internet.” (The Detroit News, July 21, 1997); “…year was an excellent time for home furnishings chains, baby store chains… and, believe it or not, even computer superstore retailers—all industry segments that posted substantial

year-over-year gains." (Discount Store News, July 7, 1997); "For instance, while there are many small computer outlets, the first computer superstore only opened in Hungary as recently as November 1996, and mail-order and telemarketing are practically nonexistent." (Journal of Commerce, July 2, 1997); "As the co-owner of a small retail computer store chain, Bielas found himself steadily shoved to the economic sidelines by computer superstores and manufacturer mass-marketing." (The San Diego Union-Tribune, July 2, 1997); "The small-business person may begin to feel that the dizzying array of products and specifications is overwhelming, especially after browsing the nearest computer superstore or reading computer magazines." (Arizona Business Cassette, June 19, 1997); "You're a witness to part of this convergence if you've strolled into a computer superstore and noticed a TV show playing on a monitor…" (The Philadelphia Inquirer, June 9, 1997); "They tend to wait until a technology proves to be a useful investment and then buy from large retail outlets and computer superstores." (The Albany Times Union, June 4, 1997); "The FTC itself purchases consumable office supplies from at least 105 different retailers, including mail-order outlets, contract stationers, mass merchants, office-supply superstores, computer superstores, electronic

superstores, local independents, and drugstores…" (The Tampa Tribune, June 3, 1997); "We're seeing that in the big office superstores as well as in the computer superstores." (Investors Business Daily, May 7, 1997); "Uncomfortable with dropping off their machines at a computer superstore, waiting for weeks for repairs and paying hefty prices, many computer users are turning to friends and friends of friends for tech assistance." (The St. Paul Pioneer Press, April 21 1997); and "In December 1995, Baretz, owner of Valens Information Systems Inc., opened More Computers Inc., a 15,000-square-foot computer superstore in this Delaware County town." (The Philadelphia Business Journal, April 10, 1997).

Based on this evidence, the Examining Attorney concluded that because "computer superstore" is generic for retail services in the field of computers, the term applicant seeks to register, "THE COMPUTER SUPERSTORE," is also generic, and hence is unregistrable on the Principal Register. He cited In re The Computer Store, Inc., 211 USPQ 72 (TTAB 1981), for the proposition that the addition of the article "the" to the generic term "computer superstore" does not convey source-identifying capacity or significance to the combined term "THE COMPUTER SUPERSTORE." In that case, the Trademark Trial and Appeal

Board found the term "THE COMPUTER STORE" to be generic for computer store services.

Applicant maintained that its mark has acquired distinctiveness within the meaning of Section 2(f) of the Lanham Act; that its mark has become famous in this country as an identification of the source of applicant's services; that its mark is not generic because applicant's use has been continuous and exclusive; and that refusal of registration of applicant's mark would be inequitable and inconsistent with prior Office practice, in view of existing registrations for marks such as "THE CONTAINER STORE," "BABY SUPERSTORES," and "CD SUPERSTORE." Included in support of applicant's arguments were declarations and exhibits which establish extensive use and promotion of the term as a mark by applicant, as well as the third-party registrations cited by applicant.

Responsive to applicant's submissions, the Examining Attorney maintained the refusal to register. He conducted another search of the Nexis database of published articles, identifying over 4500 stories wherein the term "computer superstore" (in lower case letters) appears. The first hundred of these excerpts were submitted. Ten appear to relate to applicant's computer superstores. The other 90 per cent of these stories do not appear to relate to

applicant, but rather use the wording "computer superstore" and "computer superstores" as generic terms for a specific type of retail store services, namely, providing a wide range of computers, computer products and computer accessories to retail shoppers. Although these excerpts are in some instances duplicative, they do show the term "computer superstore" used generically in reference to large retail store services in the field of computers and related products.

Also included with this Office Action were dictionary definitions of "computer" and "superstore." The latter is defined simply as "a very large store offering a wide variety of merchandise."

With regard to the specific references in the excerpts to applicant as the nation's largest computer superstore, the Examining Attorney argues that these stories also support the refusal to register. He points out that while applicant may be the largest computer superstore, the evidence indicates that applicant is not the only computer superstore. Several others, such as Microwarehouse and Best Buy, are identified by name, and many of the excerpts make it clear that there are a number of other "computer superstores" with which applicant competes.

The Examining Attorney argues that the Patent and Trademark Office is not bound by the fact that nine different state registrations and seven foreign-country registrations have issued to applicant for the mark here at issue, nor should we be bound by the fact that the third-party registrations cited by applicant for marks which combine "SUPERSTORE" with generic terms for the goods or services there involved have been issued on the Principal Register under the Lanham Act.

Based on careful consideration of the extensive record before us in this appeal, the arguments presented in the briefs and at the hearing, and the relevant statutory and legal authorities on the issues of descriptiveness and genericness, we hold that the Examining Attorney has met his burden of establishing that "THE COMPUTER SUPERSTORE" is generic in connection with the services set forth in the application, and that in view of this fact, no amount of evidence of distinctiveness can justify registration of this term on the Principal Register under the provisions of Section 2(f) of the Act.

The dictionary definitions of the individual words "computer" and "superstore" do not necessarily establish that the combination of the two words is generic, and the evidence showing that third parties have disclaimed

different generic terminology along with the word "SUPERSTORE" in their own applications and registrations of marks which combine the two is hardly dispositive of the issue of whether or not the mark which is the subject of this appeal, "THE COMPUTER SUPERSTORE," is capable of identifying and distinguishing this applicant's retail store services in the field of computers, computer products and computer accessories.

The excerpts from published articles submitted by the Examining Attorney, however, are clear and uncontroverted evidence that prospective computer purchasers understand the term to refer to the class of services with which applicant uses it. In each of the excerpts quoted above, as well as in the countless others of record in this appeal, the term "computer superstore" is used as the generic name for a large retail business featuring computers and related products.

When the word "the" is used before "computer superstore," as in the first excerpt quoted above, it is also as part of a generic term, rather than as a source-indicating service mark. The addition of the article in front of the generic term "computer superstore" does not somehow convert this generic term into a registrable service mark. Just as "THE COMPUTER STORE" was held to be

generic for computer store services in the case cited above, "THE COMPUTER SUPERSTORE" is likewise generic for the services set forth in the instant application.

Furthermore, we agree with the Examining Attorney that contrary to applicant's arguments, even the excerpts which clearly relate to applicant's business show the term used as a generic reference to the services, rather than as an indication of their source.

Applicant argues strenuously that the Examining Attorney has not identified particular computer superstores other than applicant which use the term to identify their businesses, but this argument misses the point. The evidence submitted by the Examining Attorney shows that journalists, whose work is widely exposed to the public, refer to many retailers of computers and computer products as "computer superstores." It is on this basis that we conclude that the relevant public understands the term primarily as the name of this type or class of services.

Applicant also attempts to distinguish In re The Computer Store, supra., by arguing that because applicant is the only computer superstore to be using the entire term "THE COMPUTER SUPERSTORE," including the first word "THE," as a mark, the cited case is inapplicable. In that case

the record showed that another entity was also using "THE COMPUTER STORE" for computer store services.

Again, applicant's argument is not well taken. The issue is not whether other computer superstores incorporate the term into their trademarks or service marks, but instead, the issue is whether their customers understand the term primarily to refer to the class of services they render. As noted above, the evidence establishes that these businesses are referred to as "computer superstores." It would be manifestly unreasonable to permit registration of such generic terms simply because they were preceded by the word "THE." Addition of this article, just like addition of terms like "Inc." and "Company," does not somehow create distinctiveness, and it surely should not have the effect of conferring registrability on otherwise generic terminology.

The Examining Attorney notes that it is common practice for businesses to tout their leadership in their particular fields by using language such as "the foreign car specialist" or "the real estate broker." Such references are clearly to the nature of the services being rendered, rather than to the sources of those services.

Because the record establishes that the term sought to be registered is generic, registration on the Principal

Register, even under the provisions of Section 2(f) of the Lanham Act, should not be permitted. Notwithstanding a substantial showing by applicant that it has extensively and exclusively used and promoted the term sought to be registered in connection with its services and in combination with its name and "CompUSA" mark, no amount of promotion--in fact, no amount of evidence of the acquisition of de facto secondary meaning as an indication of source—can justify the registration of a generic term. Such terms are, by definition, not subject to exclusive appropriation, in that they do not possess the capability of identifying a single source of particular services and distinguishing services rendered by that entity from similar services provided by others. See: H. Marvin Ginn Corp. v. International Association of Fire Chiefs, supra.

In fact, at the oral hearing, the Examining Attorney conceded that the evidence of applicant's extensive use and promotion unquestionably would have been sufficient to establish distinctiveness had the term in question been only merely descriptive, instead of generic. Because the term is generic, however, we need not detail the voluminous evidence submitted by applicant in support of its claim of acquired distinctiveness. Registration would not be appropriate even if de facto significance as a service

mark, or even fame, had been clearly established. If, however, on appeal, the Court were to find that the term applicant seeks to register is capable of identifying and distinguishing applicant's services, registration under the provisions of Section 2(f) of the Act would be justified.

Applicant's argument that registration is mandated because of the third-party federal registrations applicant made of record is similarly unpersuasive, as is the contention that state and foreign registrations establish a proper basis for registration under the Lanham Act. It is well settled that the Board is not bound by prior decisions of Examining Attorneys to register particular marks, and we are certainly not so bound by state or foreign government action registering the mark applicant seeks to register here. Each case before us must be decided on its own merits, based on its own record. We are not privy to the records or the reasoning that apparently led others to register this mark and other similar marks. Our decision in the instant case rests on the application of the relevant legal authority and principles as they are applied to the record in this application.

DECISION: The refusal to register under Section 2(e)(1) of the Lanham Act is affirmed.